

**REMARKS**

Claims 1-31 and 33-61 were pending in the application. Claims 32-36 and 40-47 have been canceled from the application without prejudice or disclaimer. Claim 31 is allowed. New Claims 62-64 are submitted herewith. All of the new claims are dependent claims that depend from allowed claim 31. Of the remaining claims, claims 1, 7, 15, 28, 37, 48 and 52 are independent claims. To further the prosecution of this application, amendments and arguments are submitted herewith.

Claims 1-30 and 33-61 have been rejected under 35 U.S.C 102(e) as being anticipated by Niemeyer et al. (U.S. Patent No. 6, 364,888.) Niemeyer describes a master console or station 200 shown in Fig. 1A having a viewer 202 and a support 204 “on which an operator, typically a surgeon, can rest his or her forearms while gripping two master controls (not shown in Fig. 1A), one in each hand.” The master controls, referred to hereinafter, are described as “positioned in a space 206 **inwardly** beyond the support 204.” (emphasis added). (See Niemeyer Fig. 1A; column 6, lines 1-12.) In the structure described by Niemeyer “the surgeon typically sits in a chair in **front** (emphasis added) of the control station 200....and grips the master controls....while resting his or her forearms on the support 204”.

In the structure described by Niemeyer, it is imminently clear that the master controls are entirely in front of the user, and that the user must reach forward or inward of the console to grip the controls. There is absolutely no teaching in Niemeyer of placing the controls to the side of the operator. The structure in Niemeyer does not allow that due to the manner in which the user is positioned.

Moreover, the master controls in Niemeyer, shown in Figs. 6A-6C and described at column 9, lines 5-30, are not supported from a base but are instead supported from an overhead location. As described at column 9, lines 54-56 of Niemeyer, it is clear that the master controls connect overhead as described in Fig. 6B at 717 (incorrectly shown in Fig. 6B as 117).

Accordingly, the hand held part 699 is not supported from an upper arm but is instead supported from a lower arm. Thus, Niemeyer does not teach the Applicants' claimed invention. For example, claim 1 recites “a proximal end of the hand assembly pivotally supported from said

upper positioner assembly the proximal end of the hand assembly”, and not the lower positioner assembly as taught by Niemeyer.

Niemeyer does not teach or suggest the Applicants’ claimed “assemblies being disposed... to the side of the operator.” Fig. 9 of Niemeyer shows no such relationship. In contrast, Fig. 9 is a diagram indicating the position and orientation of the hand piece of the master controller relative to an “eye” coordinate reference system, and as such does not represent position of the master controls relative to the user. Also, column 13, lines 48-57 of Niemeyer cited in the Office Action does not describe this positioning. Niemeyer merely indicates that the master controls can be brought “into a general position at which they are comfortably positioned for the surgeon.” From this statement one can not deduce the Applicants’ claimed positioning “to the side of the operator”. It is not possible with the Niemeyer structure.

Fig. 11 of Niemeyer definitely confirms the forward orientation of the master controls. As shown in Fig. 11 of Niemeyer, all of the arms of the master controller are disposed within the console housing, as represented by the word “console” in Fig. 11. Near the lower left corner of Fig. 11 there appears to be shown, the forearm support 204, although it is not numbered in Fig. 11. Fig. 11 also confirms the location of the master controls hung from an overhead location as shown at 648 in Fig. 11. From Fig. 11 it is clear that there is absolutely no way that the Niemeyer arm structure is disposed to the side or can extend in a direction along the operator’s arm.

The placement of the master controls as claimed by the Applicants claim 1 enables improved operation of the master structure by enabling the operator’s arm to extend in the direction of the arm member, thus providing enhanced master control. More precise master control occurs by having the operators arm positioned along the arm member. Refer also to the drawings of the present application and, in particular, Figs. 1 and 3 where the placement of the operator’s arm relative to the master arm member clearly illustrates this feature. Accordingly, claim 1 and its related dependent claims 2-6, 13, 14 and 19-27 should all now be in condition for allowance.

Independent Claims 7 and 15 and their related dependent claims should be found allowable for the same reasons as claim 1, relating in particular to the proximal end of the hand assembly being pivotally supported from the upper positioner assembly.

Niemeyer does not teach or suggest the Applicants' claimed "bases are remote from the slave station, and that the pair of bases are disposed, respectively, on opposite sides of the operator so as to, in operation, position the respective elongated arms adjacent to and alongside of a substantial length of the operator's arm" as recited in Applicants' claim 28. Accordingly, claim 28 and its related dependent claims 29 and 30 should be found in condition for allowance.

Claim 37 patentably distinguishes over the cited prior art for reasons previously stated. Additionally, Niemeyer's structure does not use a master unit that is remote from the instrument and has a base that is disposed "to the side of the operator ... so that the arm member ... extends ... along side at least a portion of the operator's arm." In the structure described by Niemeyer, the entire arm structure including the base is directly in front of the operator. The placement as claimed by the Applicants in claim 37 enables improved operation of the master structure by enabling the operator's arm to extend in the direction of the arm member, thus providing enhanced master control. The applicant has found that better master control is possible by this alongside positioning. Accordingly, claim 37 and its related dependent claims 38-39 should now all be found in condition for allowance.

Niemeyer does not teach a method as recited in independent claim 48 where, inter alia, the method includes "disposing the base of the master controller away from the patient support member, and laterally to the side of an assumed operative position of the medical practitioner; and having the hand of the medical practitioner grasp the hand piece while the elongated arm member extends in a direction that is substantially parallel to and alongside of the arm of the medical practitioner." Accordingly, claim 48 and its related dependent claims 49-51 should now all be found in condition for allowance.

Regarding claim 52, Niemeyer does not teach or suggest common attachment of the master bases to the support for the operator of the system. This is illustrated in Fig. 1 of the Applicants' specification by the common support brace 40. With this arrangement the operator can move or swivel without affecting the operator's relationship with the master controls. It is also noted that a further amendment has been made in claim 52 to clarify that the bases are commonly attached to a seat support for accommodating the operator. Claim 52 and its related dependent claims 53-62 should now all be found in condition for allowance.

New claims 62-64 are dependent claims from allowed claim 31 and thus are now clearly in condition for allowance. Newly added claims 62-64 recite further limitations that are neither taught or suggested by the cited prior art. For example, claim 62 recites "said arm assembly includes an arm member and said base is disposed remote from the medical instrument, and to the side of the operator", claim 63 recites "an upper positioner assembly supported over said lower positioner assembly and rotational relative to said lower positioner assembly to enable lateral side-by-side surgeon manipulation" and claim 64 recites "said hand assembly has its distal end for engagement by the surgeon's hand, and a proximal end of the hand assembly pivotally supported from said upper positioner assembly." (See Claim 37; Claim 1; Fig. 3 and Page 21 of the applicants' specification as originally filed.) No new matter is introduced.

#### Supplemental Information Disclosure Statement

A Supplemental Information Disclosure Statement (SIDS) is being filed concurrently herewith. Entry of the SIDS is respectfully requested.

#### CONCLUSION

In view of the above amendments and remarks, it is believed that all remaining claims are in condition for allowance, and it is respectfully requested that the application be passed to issue. If the Examiner feels that a telephone conference would expedite prosecution of this case, the Examiner is invited to call the undersigned.

Respectfully submitted,  
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Dated: 7/13/04